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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/527,927 03/17/00 LEWIS

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EXAMINER

PARISI, J
ART UNIT PAPER NUMBER

2166
DATE MAILED:

07/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/527,927

Applicant(s)

LEWIS, WOODSON C.

Examiner

Joe Parisi

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Reconsideration

1. This action is responsive to the response to office action, including the request for reconsideration including the affidavit under 37 C.F.R. 1.131, filed May 4, 2001 (listed as paper number 9 on the application file wrapper); the application for utility patent, filed March 17, 2000 (listed as paper number 1 on the application file wrapper); and the Information Disclosure Statement, filed August 17, 2000 (listed as paper number 4 on the application file wrapper).

Status of Claims

2. The claims currently pending before this office are numbers 1-20 as filed in applicant's initial correspondence filed on March 17, 2000. Claims 1, 9, and 18 are independent claims. Claims 1-20 are reviewed in this Office Action.

Response to Arguments

Drawings

3. The drawings were previously objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "22" and "40" were deemed to be used to designate the same admission ticket. The examiner appreciates applicant's clarification regarding the reference characters as described in the specification on page 7, lines 12-13. The objection with regard to the drawings is hereby withdrawn.

Affidavit under 37 C.F.R. 1.131

4. The affidavit submitted under 37 C.F.R. 1.131 has been fully considered, but is deemed unpersuasive and insufficient to overcome the present rejections.

37 C.F.R. 1.131 (b) requires a showing of facts establishing a prior reduction of practice, or a conception before the art cited under 35 U.S.C. 102 (a) or (e), or 35 U.S.C. 103 (a) using art from 102 (a) or (e) and due diligence to a reduction of practice.

In the present case, Applicant has sworn that he had conceived and reduced to practice prior to January 26, 2000. In support of this assertion, he has cited an executive overview (Exhibit A) of the invention as well as a Preliminary Case Summary and Funding Proposal (Exhibit B).

It is noted that by its very nature, while a proposal may in rare circumstances fully disclose an invention, it frequently provides a basis for funding for further research leading to the reduction to practice of an invention. The present case appears to be no exception to this heuristic.

37 C.F.R. 1.131 explicitly requires a "showing of fact" to establish the actual reduction to practice or constructive reduction. In the instant case, there is insufficient evidence to show completion of the invention commensurate with the extent that the invention is claimed. Applicant's reference to Exhibit A, and to the problems associated with the current ticketing system, were incorporated as a part of the business plan and proposal, but do not clearly substantiate the reduction to practice previous to the prior art.

The non-published section of Applicant's proposal relied upon is not deemed a reduction to practice of the claimed invention for the following reason: Applicant asserts that the plan will be implemented in three phases with potential implementations in different industries shown. However, the working implementation of the claimed invention is not described in the evidence before the office. In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. See *In re Asahi/ America, Inc.*, 68 F.3d 442, 445 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian* 825 F. 2d 1581, 3 U.S.P.Q.2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929 (C.C.P.A. 1931)).

Therefore, the Examiner concludes as a finding of fact, taking into account the entire submission, that Applicant failed to meet his burden of providing a "[S]howing of facts ... in character and weight, as to establish a reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence...." (37 C.F.R. 1.131).

Remarks

5. Applicant did not responded to the merits of the Ticketmaster prior art publication, since he believes that he was first to invent. However, his affidavit is insufficient to establish invention before the publications used in the rejections. Therefore, there are no material arguments traversing the rejections on the merits. Therefore, the rejections listed below are hereby maintained.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 3, and 5, 6 were rejected under 35 U.S.C. 102(a) as being anticipated by Ticketmaster.com as described in the attached article entitled, “Site to Let Buyers Print Tickets at Home” from the January 26, 2000, USA Today Tech Review (hereinafter referred to as “Ticketmaster”).

The Ticketmaster article describes an electronic ticketing and validation system whereby online ticket buyers download and print their own ticket (see page 1, paragraph 1). The ticket buyers access the Internet and buy tickets on-line (see page 1, paragraph 4). After downloading the ticket, buyers print the tickets from their computers (see page 1, paragraph 2). To redeem the ticket at the event, a bar code scanner is used at the gate to read a portion of the ticket (unique identifier code) and validate the ticket prior to allowing the buyer admission to the event (see page 1, paragraph 2).

As such, the rejection of claims 1, 3, and 5, 6 is maintained.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ticketmaster.com in the attached article entitled, "Site to Let Buyers Print Tickets at Home" from the January 26, 2000, USA Today Tech Review (hereinafter referred to as "Ticketmaster") as described above with regard to claim 1 and further in view of the attached press release by Allen Bush entitled, "3Com Announces the Palm VII connected Organizer, The First Handheld Solution for Out-of-the-Box Wireless Internet Access" from December 2, 1998 (hereinafter referred to as "Bush").

With regard to claim 2, the Ticketmaster article teaches the use of a computer with which to access, pay, and generate the ticket (see page 1, paragraphs 1,2, 4). The Ticketmaster article does not explicitly disclose the use of a hand-held computer device with which to perform these tasks. However, Bush teaches the use of a Palm-sized computer that allows Internet access and complete browsing capabilities (see page 1, paragraph 1). Further, the Palm VII allows for web clipping to a variety of sites, including Ticketmaster (see page 1, paragraph 3). One skilled in the art would be motivated to provide access to the Ticketmaster ticketing system (and thereby utilize a hand held device as the computer of choice) through a hand held computer for the convenience of the user and to allow portability. With the hand held system, a user may print

their ticket from any printer regardless of location and not be constrained by their home system or home telephone access accounts. Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to incorporate the hand held computer device as in the Bush article in the Ticketmaster system.

As such, the rejection of claim 2 is hereby maintained.

10. Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ticketmaster.com in the attached article entitled, "Site to Let Buyers Print Tickets at Home" from the January 26, 2000, USA Today Tech Review (hereinafter referred to as "Ticketmaster") as described above with regard to claim 1 and further in view of the attached web page timeline distributed by the Uniform Code Council, Inc. depicting ID Numbers and Bar Codes over the years (hereinafter referred to as "UCC Timeline").

With regard to claim 4, the Ticketmaster article teaches the use of a computer with which to access, pay, and generate the ticket (see page 1, paragraphs 1,2, 4). The Ticketmaster article does not explicitly disclose the use of a universal product code as the unique identifier with which to validate the ticket. However, the UCC Timeline shows that that Universal Product Code has been the industry standard to identify and validate products since 1973. It is further well known in the art of product identification and validation that Universal Product Codes (UPC) are used to validate a wide array of items from supermarket stock to printed matter to Patent Application file wrappers at the United States Patent and Trademark Office. One skilled in the art would be motivated to use the UPC since it is the most widely known and employed

standard for data capture and automated identification (see page 1, paragraph 1) and the widest array of printing and reading equipment is available to recognize these codes (see page 3, January 1997 heading). Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to incorporate a UPC as the unique identifier code in the Ticketmaster system. Therefore, the rejection of claim 4 is hereby maintained.

11. Claims 7 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ticketmaster.com in the attached article entitled, "Site to Let Buyers Print Tickets at Home" from the January 26, 2000, USA Today Tech Review (hereinafter referred to as "Ticketmaster") as described above with regard to claim 1 and further in view of the attached web page timeline distributed by the Washington Metropolitan Area Transit Authority depicting use of farecards and other highlights in their twenty-five year history (hereinafter referred to as "Metro").

With regard to claims 7 and 8, the Ticketmaster article teaches the use of a computer with which to access, pay, and generate the ticket (see page 1, paragraphs 1,2, 4). The Ticketmaster article does not explicitly disclose the use of a paper ticket with a magnetic strip having a code encoded thereon. However, the use of paper tickets with similar magnetic strips with coded information encoded thereon is well known in the art. An example of these types of tickets is found in the Washington Metropolitan Area Transit Authority (Metro) system. The farecard system used in the Metro utilizes a paper card with fare information stored on a magnetic strip (see page 1, farecard bullet). These farecards have been used by Metro since 1977 (see Metro Timeline, July 1, 1977). One skilled in the art would be motivated to use the paper tickets with a

magnetic strip encoded to ensure proper entry and to prevent multiple use of the ticket. The magnetic media is viable alternative to the UPC or barcode systems. Further motivation would be to employ the use of automatic turnstile systems that can read the magnetic strip and allow entry/egress without physical human intervention. This would expedite the entry/egress process. Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to incorporate a paper ticket with a magnetic strip having a coded encoded therein as a means of admission in the Ticketmaster system.

Therefore, the rejection of claims 7 and 8 is hereby maintained.

12. Claims 9 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ticketmaster.com in the attached article entitled, "Site to Let Buyers Print Tickets at Home" from the January 26, 2000, USA Today Tech Review (hereinafter referred to as "Ticketmaster") as described above with regard to claim 1 and further in view of the attached web page timeline of press releases distributed by the TeamCard depicting use of smart cards for season tickets to sporting events (hereinafter referred to as "TeamCard").

With regard to claim 9, the Ticketmaster article teaches the use of a computer with which to access, pay, and generate the ticket (see page 1, paragraphs 1,2, 4). The Ticketmaster article does not explicitly disclose the use of a season pass to gain entrance to particular events. However, TeamCard teaches the use of smart card technology to replace the traditional season-ticket booklet. The card itself becomes the season ticket (see page 1, season ticket replacement heading). The TeamCard was introduced in October 1997 (see TeamCard timeline) and has space on the card for co-branding, event, and sponsorship information (see page 2, season ticket

Art Unit: 2166

replacement heading). One skilled in the art would be motivated to use the smart card season tickets as a substitute for paper tickets to reduce ticketing costs, ensure security, and expedite entry and egress into the event forum. Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to incorporate a smart card season ticket as described by TeamCard in the Ticketmaster system.

Therefore, the rejection of claims 9 and 17 is hereby maintained.

Claim 10 is substantially similar to claim 3 with a season pass replacing the individual event ticket. As such, the rejection is maintained for similar reasons.

Claim 11 is substantially similar to claims 3 and 6 with a season pass replacing the individual event ticket. As such, the rejection is maintained for similar reasons.

Claim 12 is substantially similar to claim 7 with a season pass replacing the individual event ticket. As such, the rejection is maintained for similar reasons.

Claim 13 is substantially similar to claim 8 with a season pass replacing the individual event ticket. As such, the rejection is maintained for similar reasons.

Claim 14 is substantially similar to claims 3 and 10. As such, the rejection is maintained for similar reasons.

Claim 15 is substantially similar to claims 8 and 13. As such, the rejection is maintained for similar reasons.

Claim 16 is substantially similar to claims 8, 13, and 15. As such, the rejection is maintained for similar reasons.

Claims 18 and 19 are substantially similar to claim 1 in method form. As such, the rejection is maintained for similar reasons.

Claim 20 is substantially similar to claim 9 in method form. As such, the rejection is maintained for similar reasons.

Conclusion

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information Regarding Communication With the PTO

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Parisi whose telephone number is 703-308-7808. The examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-5140.


Joe Parisi
July 9, 2001


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100